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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,076	08/04/2005	John Kennedy	2883	7460
50855 7590 12/13/2010 Tyco Healthcare Group LP d/b/a Covidien 555 Long Wharf Drive Mail Stop 8-N1, Legal Department New Haven, CT 06511				
EXAMINER				
TENTON, LEO B				
ART UNIT		PAPER NUMBER		
1742				
MAIL DATE		DELIVERY MODE		
12/13/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/530,076

**Applicant(s)**

KENNEDY ET AL.

**Examiner**

Leo B. Tentoni

**Art Unit**

1742

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2010.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-18 is/are pending in the application.  
4a) Of the above claim(s) 12 and 15-18 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 2-11, 13 and 14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 September 2010 has been entered.

***Election/Restrictions***

2. Claims 12 and 15-18 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 17 March 2008.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-11, 13 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 2, line 9 and in claim 13, line 10, the newly-added limitation of "130°C" is not supported by the originally-filed specification and thus, constitutes new matter (the originally-filed specification supports a temperature of about 120°C to about 140°C, but there is no support for a temperature of about 130°C).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and

potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2-11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roby et al (U.S. Patent 6,191,236 A) in combination with Kokish et al (U.S. Patent 6,165,202 A).

Roby et al (see the entire document, in particular, the abstract; col. 1, lines 18-46; col. 2, line 19 to col. 4, line 65; Examples; Table I) teaches a process of making a monofilament suture from a block copolymer including at least 50 mole percent glycolide and trimethylene carbonate, including the steps of extruding the copolymer (at a temperature of from 170°C to 225°C) to form a molten monofilament, quenching the molten monofilament in a quench bath (at a temperature of from 15°C to 40°C) to provide a solidified monofilament, drawing the solidified monofilament through a first oven (at a temperature of from 25°C to 50°C) at a draw ratio of from 5:1 to 10:1, drawing the monofilament through a second oven (at a temperature up to 120°C) at a draw ratio of from 1.1:1 to 1.5:1, drawing the monofilament through a third oven (at a temperature of from 50°C to 120°C) at a draw ratio of from 0.96:1 to 0.98:1, and annealing the monofilament at a temperature up to 125°C. Roby et al does not explicitly teach the step of drawing the monofilament through a third oven (at a temperature of about 130°C) at a draw ratio of from 0.7:1 to about 0.8:1 (Roby et al does teach a step of drawing the monofilament through a third oven (at a temperature

of from 50°C to 120°C) at a draw ratio of from 0.96:1 to 0.98:1). Kokish et al (see the entire document, in particular, col. 4, lines 8-34; col. 4, line 40 to col. 6, line 11) teaches a process of making a monofilament suture (from random polymers that can be blended or copolymerized with other known absorbable polymers and copolymers (this includes block copolymers) from materials such as glycolide and trimethylene carbonate) including the step of drawing the monofilament through a third oven (at a temperature of from about 80°C to about 125°C) at a draw ratio of from about 0.75:1 to about 1.05:1, and such would have been obvious to one of ordinary skill in the art at the time the invention was made in the process of Roby et al in view of Kokish et al in order to manufacture monofilament sutures having desirable properties (e.g., tensile strength, knot strength, knot retention, absorption). The upper limit of the temperature (i.e., 125°C) of the third oven taught by Kokish et al meets the claimed limitation of "about 130°C" because (1) the instant claims use the term "about" which allows for some flexibility (or leeway) in the range (i.e., the temperature of the third oven may be below 130°C, including a temperature of 125°C), and (2) there is no disclosed criticality of the claimed temperature range of the third oven and where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation (MPEP §2144.05(II) (A)).

***Response to Arguments***

8. Applicant's arguments with respect to claims 2-11, 13 and 14 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo B. Tentoni whose telephone number is (571) 272-1209. The examiner can normally be reached on Monday - Friday (6:30 A.M. - 3:00 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leo B. Tentoni/  
Primary Examiner, Art Unit 1742